

Amendments to the Drawings:

The attached drawing shows new Figure 9 which depicts the net in a rectangular shape. No new matter has been added.

REMARKS

Claims 12-19 are pending in the application. The Examiner has rejected claims 12-19.

Amendments to Claims

In the claims, claims 12 and 16 have been amended as required by the Examiner (Examiner referred to claim 12 as claim 1 on page 3 of the Office Action) to overcome the objection of claims 12 and 16 to clarify the border. The Applicant has also amended claims 16-19 to state that an apparatus is being claimed. Applicant believes no new matter has been added.

Amendments to Specification

In the specification, a new paragraph has been added describing Figure 9. Applicant believes no new matter has been added.

Amendments to Drawings

An additional drawing has been added to show the net in a rectangular shape. The new drawing is shown as Figure 9. Applicant believes no new matter has been added.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 12-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,098,750 issued to Reynolds (“Reynolds ‘750”) in view of U.S. Pat. No. 6,138,327 issued to Powell (“Powell ‘327”). The Applicant respectfully disagrees with Examiner’s position.

I. THE EXAMINER FAILED TO MAKE OUT A PRIMA FACIE CASE OF OBVIOUSNESS TO SUPPORT A REJECTION UNDER 35 U.S.C. §103 OF ANY OF APPLICANT’S CLAIMS

The Examiner has failed to establish a prima facie case of obviousness. When examining a patent application, the Examiner has the initial burden of factually supporting a prima facie conclusion of obviousness. *Legal Concepts of Prima Facie Obviousness* MPEP 2142. If the Examiner fails to put forth a prima facie case of obviousness, Applicant has no obligation to come forward with evidence of non-obviousness. *Id.* For the Examiner to establish a prima facie case of obviousness, three criteria must be met. *Establishing a Prima Facie Case of Obviousness*, MPEP 2142. First, there must be a suggestion or motivation to modify or combine the prior art references. *Id.* Second, there must be a reasonable expectation of success. *Id.* Third, the prior art reference must teach or suggest all the claim limitations. *Id.* The Applicant respectfully asserts that the Examiner has failed to meet its evidentiary burden.

1. The Examiner did not cite any suggestion, teaching, or motivation to select and combine Reynolds ‘750 and Powell ‘327 to yield the Applicant’s claimed invention.

Case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). *See also*, *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (stating “the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). Combining prior

art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *See, Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”). The evidence of a suggestion, teaching, or motivation to combine the references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved, yet, the range of sources does not diminish the requirement for actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Claims 12-19

The Examiner did not satisfy the evidentiary requirements to prove that the Reynolds '750 or the Powell '327 references suggest a *motivation to combine their teachings* to disclose or suggest Applicant's claims 12-19. Rather, the Examiner stated that it would have been obvious to one skilled in the art to use the straps provided by Powell '327 to connect the net to the support member provided by Reynolds '750 in order to offer a strap that locks to a given diameter and provides additional gripping support with the rubberized sleeve. The Examiner's conclusion necessarily relied not on an individual with ordinary skill in the art, but on an individual with 20/20 hindsight and Applicant's disclosure as a blueprint for a solution.

The problem faced by the inventor was how to create a net assembly that would provide a way to attach a net to a support member such that the net does not move. Associated with this problem are additional issues related to why the current or prior art is deficient to solve the problem. One example of an associated problem was how to attach a safety net to a support member such that the net does not move and without having any sagging in the net. The Examiner never considered this problem, particularly because the Examiner had the benefit of the Applicant's disclosure, which enabled her to see past this additional problem and focus on the solution. In other words, the Examiner solved the problem of “how to create a *safety net that is attached to a support member*” not, “how to create a

safety net that is connected to a support member such that the net does not move and with no sag in the net.” The safety net is attached to the support member using a plurality of lock fasteners so that the safety net does not move and does not have any sag or slack. The lock fasteners in the present invention are used to attach the safety net to the support member.

In contrast, the purpose of the fasteners in Reynolds ‘750 is to moveably connect the net to the support member so that the net can be folded down when the whole net system is retracted. (Reynolds Col. 2, lines 62-67). Specifically, as shown in Fig. 2 of Reynolds ‘750, the safety net is collapsible and folds on itself while still attached to the support members. Thus, Reynolds ‘750 does not teach the use of fasteners to non-moveably attach a safety net to a support member.

The Examiner did not indicate a suggestion or motivation to combine Reynolds ‘750 and Powell ‘327 to create a safety net that is non-moveably attached to a support member. The Examiner merely indicated that “it would have been obvious to one skilled in the art, to use the straps provided by Powell, to connect the net to the support member provided by Reynolds, in order to offer a strap that locks to a given diameter and provides additional gripping support with the rubberized sleeve.” (Examiner’s Office Action p. 4). This statement does not provide a suggestion or motivation to combine Reynolds ‘750 and Powell ‘327. Thus, the Examiner improperly relied on Applicant’s disclosure as a blueprint for solving the problem.

Because the Examiner failed to explain why an ordinarily skilled person when faced with the problem solved by Applicant’s invention, would 1) reason that the prior art was somehow deficient to solve that problem; and 2) be motivated to select the cited references and combine them, it follows that the Examiner’s rejection fails to meet *prima facie* requirements for an obvious rejection under 35 U.S.C. §103. *See also, In re Rouffet*, 149 F.3d 1350, 1359, 147 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (holding that an examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with *no knowledge of the claimed invention*, would have been motivated to select the references, and select the relevant elements from the references for combination in the manner claimed) (emphasis added).

2. There is no reasonable expectation of success that the Reynolds ‘750 and Powell ‘327 references can be combined to yield the Applicant’s invention without destroying the principle of operation of the Reynolds ‘750 device.

A conclusion of obviousness can be maintained by showing a reasonable expectation of success. *In re Rinehart*, 531 F.2d 1048, 1054 (CCPA 1976). However, “[i]f a proposed modification or combination of the prior art would change the operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.” See, *The Proposed Modification Cannot Change the principle of Operation of a Reference*, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). In the present case, there is no reasonable expectation of success when combining Reynolds ‘750 and Powell ‘327 that does not also destroy the principle of operation of the Reynolds ‘750 apparatus.

If Reynolds ‘750 were combined with the teachings of Powell ‘327, the movable safety net of Reynolds ‘750 would not effectively retract when not in use. If Powell ‘327 was combined with Reynolds ‘750, the retractable safety net system of Reynolds ‘750 would be non-movably attached to the support member. (Reynolds ‘750, Col. 2, lines 62-67). The modified attachment mechanism would destroy one of the objects of the Reynolds ‘750 patent (i.e. the safety net collapsing on itself to allow access between the posts for people or machinery). If the safety net of Reynolds ‘750 were attached to the support members with the fasteners of Powell ‘327, it would be very difficult for the safety net collapse on itself. The Reynolds ‘750 patent discloses that the safety net can move out of the way to allow access between the posts by people or machinery. (Reynolds ‘750, Col. 2, lines 62-67). If the fasteners of Powell ‘327 were used to secure the safety net of Reynolds ‘750 to its support members, it would be virtually impossible for the safety net to collapse on itself since the fasteners of Powell ‘327 once engaged do not allow the attached items to easily move. (Powell ‘327, Col. 1, lines 47-50). Thus, there is no reasonable expectation of success to support a conclusion of obviousness.

3. The Reynolds ‘750 and Powell ‘327 references are non-analogous prior art to Applicant’s present invention.

When analyzing the obviousness of the subject matter at issue, the prior art references must be analogous. *See*, MPEP 2141.01(a). “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Moreover, the similarities and differences in the structure and function of the inventions are important in determining the non-analogy or analogy of the references. *See, In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). In the present case, the structures and functions of Reynolds ‘750 and Powell ‘327 are not similar to the present invention.

The prior art references and claimed invention involve different structures and functions. Applicant’s invention discloses a safety net system that is non-moveably attached to support members on all four sides. Specifically, the Applicant describes an apparatus and method for supporting a net along a support member. The invention resides in a safety net, a support member, and a plurality of lock fasteners. The safety net is non-movably attached to the support members using the plurality of lock fasteners.

In contrast, the movable safety net disclosed in Reynolds ‘750 is used as part of a different structure for a different purpose under different conditions from the net disclosed by Applicant. The movable safety net device in Reynolds ‘750 has a position where the “safety net **60** is out of the way, and allows access between the posts **20** and **30** by people or machinery.” (Reynolds ‘750, Col. 2, lines 62-67). Moreover, the Reynolds ‘750 moveable safety net is not structurally similar to the Applicant’s safety net. Reynolds ‘750 does not disclose *lock fasteners* to attach the border of the safety net to the support members. Rather, as previously stated, the net in Reynolds ‘750 is designed to collapse on itself and therefore move along the support members. (Reynolds ‘750, Col. 2, lines 62-67). These differences render Reynolds ‘750 a non-analogous prior art reference.

Similarly, Powell ‘327 is also a non-analogous prior art reference. The intended purpose of Powell ‘327 is to provide a fastener that binds and/or bundles objects together. However, the fasteners in Powell ‘327 do not provide the structural strength to secure the

safety net of Applicant's invention to the support members as they are designed. Specifically, the fasteners in Powell '327 are designed to provide *flexibility* and *stretchability*. (Powell '327, Col. 1, line 49). Fasteners that provide flexibility and stretchability would not properly hold the safety net of Applicant's invention in place without sagging. Thus, the differences in structure, purpose, and conditions make Powell '327 a non-analogous prior art reference.

Conclusion

Applicant believes he has addressed and responded to every point raised in the Examiner's present action. For the reasons stated above, Applicant respectfully requests reconsideration of his application.

Respectfully submitted,

Date: 10/19/2006

/Carey Brandt Anthony/
Carey Brandt Anthony, Reg. No. 55,022
Venable, Campillo, Logan & Meaney, P.C.
Attorneys for Applicant
1938 E. Osborn Road
Phoenix, Arizona 85016
(602) 631-9100